REMARKS

Request for reconsideration and allowance of all the pending claims are respectfully requested in light of the following remarks. Claims 1-22 are pending herein and stand rejected.

Claims 1-4, 6-12, 14-16 & 18-21 stand rejected under 35 U.S.C. §103(a) as allegedly being unpatenable over Bruls (U.S. 6,459,850).

Applicant respectfully disagrees with, and explicitly traverses, the examiner's reason for rejecting the claims. A claimed invention is prima facie obvious when three basic criteria are met. First, there must be some suggestion or motivation, either in the reference themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine the teachings therein. Second, there must be a reasonable expectation of success. And, third, the prior art reference or combined references must teach or suggest all the claim limitations.

With regard to claim 1, this claim recites:

> 1. A method for automatically adjusting recording bit rates, the method comprising the steps of:
>
> (a) receiving a plurality of video programs;

(b) concurrently with step (a), analyzing said video programs into a plurality of categories according to the contents of said video programs;

(c) determining target bit rates for the respective said video programs according to the corresponding analysis outcome; and,

(d) encoding said video programs based on the corresponding target bit rates determined in step (c).

Independent claims 8 and 14 recite similar limitations.

Bruls discloses a recording device that includes a compression unit whose bit rate is influenced by a system controller via a control input during the encoding process *depending on the remaining part of the vacant data space on the information carrier and the remaining duration of the program.* When parameters that influence the bit rate are set in the compression unit, the system controller will take the complexity of the program derived during a previously encoded part of the program into account. Furthermore, a separate encoding device receives time information and data space information. Also, the control of *the bit rate of a compression unit depends on the time, data space and program complexity information.* See Abstract.

As admitted by the examiner, Bruls fails to disclose "receiving a plurality of video programs," as recited in independent claim 1.

Still further, Bruls fails to disclose or suggest, "concurrently with step (a), analyzing said video programs into a plurality of categories according to the contents of said video programs," as recited in independent claim 1. As noted above, Bruls bit rate is influenced by a system controller via a control input during the encoding process *depending on the remaining part of the vacant data space on the information carrier and the remaining duration of the program.* Accordingly, Bruls does not analyze said video programs into a plurality of categories according to the contents of said video programs. Moreover, since Bruls teaches to fit a program of a certain duration that is converted into compressed data (encoded), in an available data space, for example, when recorded on an information carrier; there is no need in Bruls to categorize the data according to the content of the program,

Having shown that the combined device resulting from the teachings of the cited references does not include all the elements of the present invention, applicant submits that the reasons for the examiner's rejections of the claims have been overcome and can no longer be sustained. Applicant respectfully requests reconsideration, withdrawal of the rejection and allowance of the claims.

In the matter of obviousness there is a great emphasis placed on "the importance of the motivation to combine." For example, the court in Yamanouchi Pharmaceutical Co. v. Danbury Pharmacal, Inc. 231 F. 3d. 1339, 56 USPQ2d. 1641, 1644 (Fed. Cir. 2000) found that:

> an examiner ... may often find every element of a claimed invention in the prior art. If identification of each claimed

> element of the prior art was sufficient to negate patentability, very few patents would ever issue. Furthermore rejecting patents solely by finding prior art corollaries for the claimed elements would permit an examiner ... to use the claimed invention itself as a blueprint for piecing together elements in the prior art to defeat the patentability of the claimed invention ... To counter this potential weakness in the obviousness construct, the suggestion to combine requirements stands as a critical safeguard against hindsight analysis and rote application of the legal test for obviousness. id. quoting In re Rouffet, 149 F.3d 1350, 1357-58, 47 USPQ 2d 1453, 1457 (Fed. Cir. 1998)

In view of the foregoing discussion, the Office Action has failed to make out a *prima facie* case of obviousness, instant independent claims 1, 8 and 14 are allowable and the rejection should be withdrawn.

Claims 5, 13, 17 and 22 stand rejected under 35 U.S.C. §103(a) as allegedly being unpatenable over Bruls in view of Kikuchi et al. (U.S. 6,577,811).

Applicant respectfully disagrees with, and explicitly traverses, the examiner's reason for rejecting the claims. As shown previously, independent claims 1, 8 and 14 contain subject matter not disclosed by the cited reference. Accordingly, applicant's remarks made in response to the examiner's rejection of claims 1, 8 and 14 are also applicable in response to the examiner's rejection of claims 5, 13, 17 and 22. Applicant, therefore, submits that in view of the remarks made with regard to the rejection of claims 1, 8 and 14, which are repeated herein in response to the rejection of claims 5, 13, 17 and 22, the examiner's reasons for rejecting claims 5, 13, 17 and 22 have been overcome and the rejection can no longer be sustained. Applicant respectfully requests withdrawal of the rejection and allowance of the claims.

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Further, dependent claims 2-7, 9-13 and 15-22 are dependent from one of the independent claims discussed above, and are believed allowable for at least the same reasons and any rejections thereof should be withdrawn.

For all the foregoing reasons, it is respectfully submitted that all the present claims are patentable in view of the cited references. A Notice of Allowance is respectfully requested.

Respectfully submitted,

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